



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/800,306 | 03/12/2004 | Michael D. Griffin | 03-12896 | 1754 |

25189 7590 02/08/2005

CISLO & THOMAS, LLP
233 WILSHIRE BLVD
SUITE 900
SANTA MONICA, CA 90401-1211

EXAMINER

SAM, CHARLES H

ART UNIT PAPER NUMBER

3731

DATE MAILED: 02/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/800,306

Applicant(s)

GRIFFIN ET AL. *Q*

Examiner

Charles H. Sam

Art Unit

3731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 3731

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 1,6,16 and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Newman et al. (2002/0143352). Newman discloses a surgical scalpel comprising a blade 30, a housing 40 movable between a distal position where the housing prevents inadvertent access to the blade and a proximal position where the housing exposes the blade for use, and an actuatable tab 41 having guide member 42.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 2,3,7,8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Newman et al. (2002/0143352) in view of Takase (5,078,724). Newman discloses the invention as claimed except for a removable blade. However, Takase teaches a surgical scalpel comprising a handle and a

Art Unit: 3731

removable blade having a blade actuator. It would have been obvious to one having an ordinary skill in the art at the time the invention was made to modify Newman by having a removable blade in view of Takase for providing a scalpel that can be used with a disposable blade.

Regarding claim 3, Newman discloses the top and bottom channel as shown in figures 1,2,4-8.

Regarding claim 7, Newman discloses the guide member 42 coupled to the top channel.

Regarding claim 8, it was very well known in the art to have a blade made of plastic.

Regarding claim 9, the device of Newman in view of Takase is inherently capable of performing the recited method steps.

3. Claims 4, are rejected under 35 U.S.C. 103(a) as being unpatentable over Newman et al. (2002/0143352) in view of Takase (5,078,724) as applied to claims 2,3,7 and 8 above, and further in view of Machida (4,922,614). Newman in view of Takase discloses the invention as claimed except for a groove and stop on the blade receiving portion. However, Machida discloses a cutting device comprising a blade receiving portion as shown in figure 2 including a groove and blade stopping means. It would have been obvious to one having an ordinary skill in the art at the time the invention was made to modify Newman by including a groove and stop in view of Machida to provide ease in attaching the blade to the handle or detaching the blade from the handle.

Art Unit: 3731

4. Claims 5,10-15,17-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Newman et al. (2002/0143352) in view of Takase (5,078,724) as applied to claims 2,3,7 and 8 above, and further in view of Herbert et al. (5,868,771). Newman in view of Takase discloses the invention as claimed except for a retaining member. However, Herbert discloses a scalpel blade cover comprising retaining members 226 and 227. It would have been obvious to one having an ordinary skill in the art at the time the invention was made to modify Newman by including retaining members in view of Herbert to maintain the blade in a preferred position within the housing.

Regarding claim 11, note Newman et al. reference, page 3, column 2, lines 4-8.

Regarding claims 12,14 and 21, note figures 2 and 3 of Newman et al. reference.

Regarding claims 13 and 19, Newman discloses the guide member 42 coupled to the top channel.

Regarding claim 15, it was very well known in the art to have a blade made of plastic.

Regarding claim 17, Machida's reference discloses the groove and stopping means.

5. Claims 23 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Newman et al. (2002/0143352) in view of Davison et al. (5,324,299). Newman discloses the invention as claimed except for a handle integral with the blade. However, Davison discloses a surgical scalpel comprising

Art Unit: 3731

a blade integral with a handle. It would have been obvious to one having an ordinary skill in the art at the time the invention was made to modify Newman by having a handle integral with the blade in view of Davison to provide a strong connection between the blade and the handle.

Regarding claim 24, it was very well known in the art to have a blade made of plastic.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles H. Sam whose telephone number is (571) 272-4703. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anhtuan T. Nguyen can be reached on (571) 272-4963. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

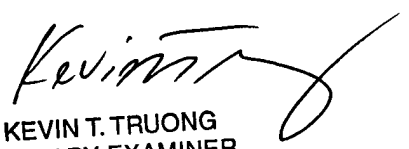
Art Unit: 3731

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



chs

January 31, 2005


KEVIN T. TRUONG
PRIMARY EXAMINER